

REMARKS

Claims 1-78 were pending in the application. Claims 32, 38, 40-45, 48, 52, 54, 55, and 58 have been amended. New claims 79-98 have been added. Claims 1-31, 33-37, 39, 46, 47, 49-51, 53, 56, 57, and 59-78 have been cancelled without prejudice.

The claims were amended to specifically identify claimed sequences, remove reference to non-elected sequences, further clarify the claim language and correct obvious typographical mistakes. Support for the claim amendments and for new claims 79-98 can be found throughout the application as originally filed including, for example, in Tables 7 and 14-16, and paragraphs [0008], [0029], [0030], [0066], [0072], [0078], [0167], [0168], [0184], [0185], and [0308].¹

No new matter has been added.

Upon entry of this amendment, claims 32, 38, 40-45, 48, 52, 54, 55, 58 and 79-98 will be pending.

Restriction Requirement

Claims 1-78 are subject to a restriction requirement. The Examiner required Applicants to elect one of thirteen allegedly patentably distinct inventions for examination. The thirteen major groups set forth by the Examiner encompass a total of 169 subgroups. Although Applicants respectfully traverse the restriction requirement on the grounds that searching more than one invention would not constitute a serious burden, Applicants provisionally elect herein Group X, subgroup 124, said to be drawn to "claim(s) 52, 53, drawn to a method diagnosing cancer ... classified in class 436, subclass 64, for example" (Office Action, pages 4-5). More specifically, Applicants elect the sequences designated as hD U-007.1 (SEQ ID NO:40; human genomic sequence), hR U-007.1 (SEQ ID NO:41, human coding sequence) and hP U-007.1 (SEQ ID NO:42, human protein sequence) (see Table 7). Applicants respectfully assert that, at a minimum, claims 52 and 53, as well as new claims 90-92 (which depend from claims 52 and 53) should be examined together.

¹ Paragraph numbers are set forth in the published application, U. S. Patent Application Publication No. 20040197778.

Notwithstanding the foregoing, Applicants respectfully assert that several of the groups identified in the Office Action are amenable to further grouping and that such further grouping would not impose a serious burden on the Examiner. For example, Applicants assert that searching other groups associated with measuring expression levels of gene products would not cause a serious burden. For example, Applicants respectfully fully submit that Groups V and IX could readily be searches in combination with Group X. Applicants note that both groups include measuring and comparing gene expression levels between a test sample and a control sample.

Applicants reserve the right to prosecute the claims encompassed by any of the non-elected groups in future divisional applications.

Conclusion

The examination of the pending claims and passage to allowance are respectfully requested. An early Notice of Allowance is therefore earnestly solicited. Applicants invite the Examiner to contact the undersigned at (302) 778-8458 to clarify any unresolved issues raised by this response.

Please apply any charges or credits to Deposit Account 06-1050 referencing Attorney Docket No. 20366-034US1.

Respectfully submitted,



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